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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,595	09/04/2001	Naohiko Ichimura	011120	1708

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EXAMINER	
VORTMAN, ANATOLY	
ART UNIT	**PAPER NUMBER**
2835	

DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/944,595	ICHIMURA, NAOHIKO	
	Examiner	Art Unit	
	Anatoly Vortman	2835	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 November 2003 (RCE)*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed on 11/07/03 in this application after final rejection (mailed on 06/10/03). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission (Response under 37 CFR 1.116) filed on 09/09/03 has been entered. No amendments to the claims have been made by the aforementioned response.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-5, are rejected under 35 U.S.C. 103(a) as being unpatentable over 2002/0053629 to Hokugoh in view of US/6,231,020 to Willson.

Regarding claim 1, 4, and 5, Hokugoh disclosed (Fig. 1-11) a display device comprising:

a display part (3); and a base part (4) supporting the display part (3), said base part (4) comprising:

a tilt unit (13) to mount the display part (3) thereon for rotation about a first axis;

a first member (14) directly or indirectly supporting the tilt unit (13);

a second member (11) disposed in a facing relationship with the first member (14);

a guide part (21, 22, 53, 54) provided on one of the first member (14) and the second member (11) for relative rotation therebetween about a second axis different from the first axis;

and at least one low friction member (12) disposed between the first member (14) and the second member (11).

Regarding claims 2 and 3, Hokugoh disclosed a cover (15) having an aperture (61), wherein the tilt unit (13) is fixed to the first member (14) through the aperture (61) of the cover (15), (Fig. 3), the cover (15) is indirectly fixed to the first member (14), and the first member (14) is disposed between the cover (15) and the second member (11).

Regarding claims 1-5, Hokugoh did **not** disclose that said low friction member comprises a plurality of generally spherical ball-shaped or mushroom-shaped members.

Willson disclosed (Fig. 6) a swivel device for computer equipment comprising a plurality of generally spherical ball-shaped low friction members (86) disposed between first (40) and second (44) members.

Since the inventions of Hokugoh and of Willson are from the same field of endeavor (swiveling support devices for computer equipment), the purpose of the spherical ball-shaped low friction members disclosed by Willson would be recognized in the invention of Hokugoh.

It would have been obvious to a person of ordinary skill in computer art at the time the invention was made to substitute the low friction member (12) of Hokugoh with a plurality of spherical ball-shaped low friction members as taught by Willson, in order to enhance convenience for a user by reducing the friction between said first and second members of Hokugoh.

Response to Arguments

4. Applicant's arguments are not persuasive. The main thrust of the Applicant's arguments is directed to the assertion that there is no motivation to combine references of Hokugoh ('629) and of Willson ('020). The Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA) 1969. In this case, the using spherical ball-shaped members of Willson instead of low-friction member of Hokugoh would definitely suggest to person of ordinary skill in the computer art at the time the invention was made that the combination would be successful. Indeed, it was notoriously known in the computer art at the time the invention was made that rolling friction between two components is

lower than sliding friction between the same two components, hence, inherently the two members separated by rolling boll-shaped members (like in Willson) would have lower friction between each other than two members separated by sliding sheet (like in Hokugoh). The Applicant implicitly has admitted the same fact in the arguments by stating: "[It] should also be noted that as shown in Figure 1 of Hokugoh, the sliding sheet only provides sliding action to a light weight liquid crystal display 1 which might weight about 6-7 pounds. In contradistinction, as clearly shown in Figure 2 of Willson, the ball bearings are meant to provide rolling action to a platform 40, a cathode ray tube display and a computer. The weights of these items added together might very well be 60-70 pounds. Therefore, the ball bearing of Willson is designed to provide sliding action to items that weight 10 times more than the sliding sheet 12 of Willson [sic]." Thus, Applicant recognizes that boll-shaped members of Willson would provide lower friction than sliding sheet of Hokugoh. As such, the idea of combining the aforementioned two references would have definitely suggested to a person of ordinary skill in the computer art at the time the invention was made that success of said combination should have been reasonably expected. As decided in *In re O'Farrel*, 7 USPQ 2d, 1673-1681, Fed. Cir. 1988, obviousness does not require absolute predictability of success. Indeed, for many inventions that seem quite obvious, there is no absolute predictability of success until the invention is reduced to practice. There is always at least a possibility of unexpected results that would then provide an objective basis for showing that the invention, although apparently obvious, was in law nonobvious. *In re Merck & Co.*, 800 F.2d at 1098, 231 USPQ at 380; *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1461, 221 USPQ 481, 488 (Fed. Cir. 1984); *In re Papesch*, 315 F.2d 381, 386-387, 137 USPQ 43, 47-48 (CCPA 1963). For obviousness under 35

U.S.C. 103, all that is required is a reasonable expectation of success. In re Longi, 759 F.2d 887, 897, 225 USPQ 645, 651-652 (Fed. Cir. 1985); In re Clinton, 527 F.2d 1226, 1228, 188 USPQ 365, 367 (CCPA 1976).

Furthermore, regarding the Applicant's arguments that Examiner's rejection is of "hindsight nature" (p.5), it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971).

Conclusion

5. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anatoly Vortman whose telephone number is 703-308-7824. The examiner can normally be reached on Monday-Friday, between 9:30am and 6:00 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Darren Schuberg can be reached on 703-308-4815. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1782.

Anatoly Vortman
Primary Examiner
Art Unit 2835

A.V.